REMARKS

Reconsideration and allowance are respectfully requested.

Claims 2, 7 and 10 are canceled and new claims 11-14 are added. Thus, claims 1, 2-6 and 8-9, and 11-14 are pending.

Remarks Regarding Claim Amendments

Claims 2 and 10 are canceled without prejudice or disclaimer. The amendment to claim 1 is supported by original claim 2. The amendments to claims 3 and 5 are supported throughout the specification, such as, for example, in original claims 3 and 5. New claims 11-14 are supported by original claims 1 and 7.

No new matter is added and entry of the claim amendments are requested.

Remarks Regarding Section 112

Claims 7 and 10 stand rejected under 35 U.S.C. § 112 in numbered section 1 of the Office Action as allegedly indefinite. Applicants traverse.

Claim 7 and 10 are canceled. Canceled claim 7 is replaced with new claims 11-14 which are not process claims and which complies with 35 U.S.C. § 112. Thus, this rejection is moot and its withdrawal is requested.

Remarks Regarding Section 101

Claims 7 and 10 stand rejected under 35 U.S.C. § 101 in numbered section 1 of the Office Action as allegedly containing "an improper definition of a process. Applicants traverse.

Claim 7 and 10 are canceled. Canceled claim 7 is replaced with new claims 11-14 which are not process claims and which complies with 35 U.S.C. § 101. Thus, this rejection is moot and its withdrawal is requested.

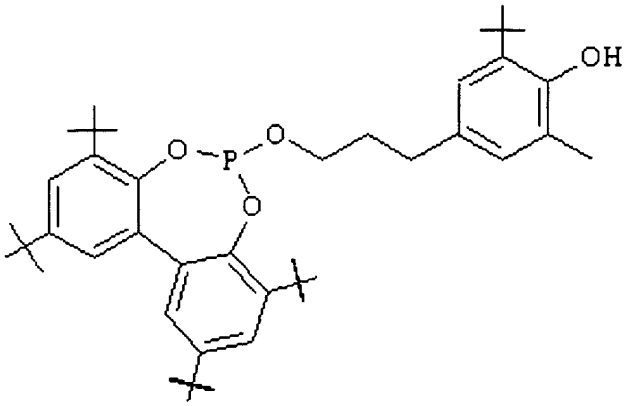
Remarks Regarding Section 102

A claim is anticipated only if each and every limitation as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical

invention must be shown in as complete detail as is claimed. See *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1-3 stand rejected under 35 U.S.C. § 102 as allegedly anticipated by Wu (U.S. Patent no. 6,759,461). Applicants traverse.

Solely to expedite prosecution, and without addressing the merits of the Examiner's position, Applicants have amended claim 1 to recite, a radiation-curable resin composition comprising A) a compound of formula (1):



(1)

A compound of formula (I) is not disclosed by Wu. Applicants submit that this feature of their claimed invention, as recited in amended claim 1, is sufficient to distinguish over Wu. Claim 2 is canceled and no further comments will be made about it. Claim 3, depending from claim 1, is also not anticipated by the Wu because the limitations of claim 1 is incorporated in claims depending therefrom. See *In re McCarn*, 101 USPQ 411, 413 (C.C.P.A. 1954).

Withdrawal of the Section 102 rejection is requested because Wu fails to disclose all limitations of the claimed invention.

Remarks Regarding Section 103

A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. *In re Kahn*, 78 USPQ2d 1329, 1334 (Fed. Cir. 2006) citing *Graham v. John Deere*, 148 USPQ 459 (1966). The *Graham* analysis needs to be made explicitly. *KSR v. Teleflex*, 82 USPQ2d 1385, 1396

that is neither disclosed nor rendered obvious by a combination of Wu and Shustack. Each one of claims 3-6 and 8-9 depend on claim 1 and are not rendered obvious by the cited documents because all limitations of the independent claim 1 are incorporated in their dependent claims. M.P.E.P. § 2143.03 citing *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). Applicants submit that this feature of their claimed invention (i.e., formula (I) above) is sufficient to distinguish over the combination of Wu and Shustack so any other incorrect allegations about their disclosures are not disputed here, but the opportunity to dispute them in the future is reserved.

Withdrawal of the Section 103 rejections is requested because the claims would not have been obvious to one of ordinarily skill in the art when this invention was made.

Conclusion

Having fully responded to the pending Office Action, Applicants submit that the claims are in condition for allowance and earnestly solicit an early Notice to that effect. The Examiner is invited to contact the undersigned if any further information is required.

Respectfully submitted,

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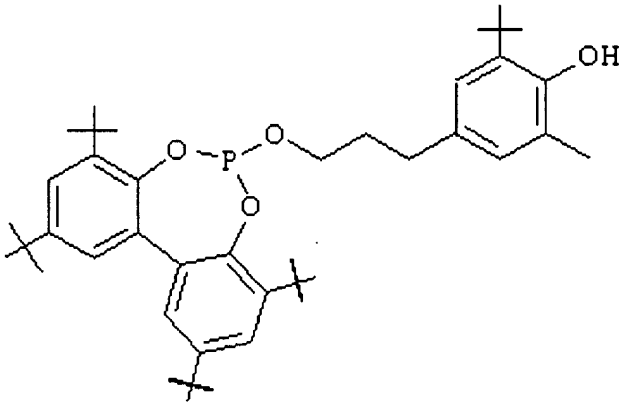
(2007). It requires findings of fact and a rational basis for combining the prior art disclosures to produce the claimed invention. See id. ("Often, it will be necessary for a court to look to interrelated teachings of multiple patents . . . and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue"). The use of hindsight reasoning is impermissible. See id. at 1397 ("A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning"). Thus, a prima facie case of obviousness requires "some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct." *Kahn* at 1335; see *KSR* at 1396.

Claims 2-6 and 8-9 stand rejected under 35 U.S.C. § 103 as allegedly obvious in view of a combination of Wu (U.S. Patent no. 6,759,461) and Shustack (U.S. Patent No. 5,146,531). See, Office Action, numbered sections 7 and 8. Claim 2 is canceled and no further comments will be made about it. Applicants traverse this rejection. Specifically, it is the Examiner's position that Wu teaches Applicants' claimed "specified stabilizer, such as organic surfactants, hindered phenols or mixtures thereof" and that Shustack teaches the other recitations of claims 2-6 and 8-9.

Solely in an effort to expedite prosecution, and without addressing the merits of the Examiner's position, Applicants have amended claim 1 so that it recites a chemical formula:



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